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WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP
1250 CONNECTICUT AVENUE, NW
SUITE 700
WASHINGTON, DC 20036

EXAMINER

MCCLELLAND, KIMBERLY KEIL

ART UNIT	PAPER NUMBER
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1791

NOTIFICATION DATE	DELIVERY MODE
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05/07/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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patentmail@whda.com

DETAILED ACTION

Response to Amendment

1. Applicant is reminded they need to explicitly point out where support for all the newly claimed features comes from as required by MPEP 714.02 and 2163.06. See 37 CFR 1.111.

Claim Rejections - 35 USC § 112

2. The previous rejections of claims 1-2 under 35 U.S.C. 112 are withdrawn.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent NO. 6,634,401 to Kuhn et al.
5. With respect to claim 1, the terms “supporting means”, “precut means” and “peeling means” are being treated under 35 U.S.C. 112, sixth paragraph. Kuhn et al. discloses a tape applicator, including supporting means (102) for supporting a strip material including a film stuck on a surface of a base sheet; pre-cutting means (122) for

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forming a cut in said film of said strip material fed from the supporting means, thereby forming a pre-cut portion of said film; a peeling means (154) for peeling the pre-cut portion of said film from said base sheet, said peeling plate being located downstream of said pre-cutting means in the sheet feeding direction; and a press roller (152) positioned at a downstream end of said peeling means, in the sheet feeding direction for pressing the pre-cut portion of said film on a substrate, wherein said pre-cutting means is configured such that the cut is made from a face of said film opposite the face of said film which is to be peeled from the base sheet by said peeling means, and wherein said press roller is configured to press the pre-cut portion of said film on the face of said film opposite the face of said film peeled from the base sheet by said peeling means (See Figure 3).

6. 35 U.S.C. 112, sixth paragraph states that a claim limitation expressed in means-plus-function language "shall be construed to cover the corresponding structure...described in the specification and equivalents thereof." Therefore, the cutter (122; Figure 3) taught by Kuhn et al. reads on die cutter recited in the current claim language because the features are drawn to an equivalent structure which performs the same function as the recited pre-cutting means under 35 U.S.C. 112, sixth paragraph.

7. The examiner would like to note that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997); "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard

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Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). See MPEP § 2114.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent NO. 6,634,401 to Kuhn et al. as applied to claim 1 above, and further in view of U.S. Patent No. 5,730,816 to Murphy.

10. With respect to claim 2, the terms “supporting means” and “precut means” are being treated under 35 U.S.C. 112, sixth paragraph. Kuhn et al. discloses a lamination device, including a tension control means (116) is disposed between said supporting means (102) and a precut means (122), wherein (See Figure 3). However, Okada et al. does not specifically disclose the tension control means comprises a dancer roller, which is movable vertically so as to allow the strip material to be fed out toward said

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press roller while giving tension due to its own weight to said strip material or first and second sensors for detecting a raised position and a lowered position of the dancer roller respectively.

11. Murphy discloses a label stripping apparatus, including a dancer roller (103), which is movable vertically so as to allow the strip material to be fed out toward said press roller while giving tension due to its own weight to said strip material and first and second sensors for detecting a raised position and a lowered position of the dancer roller respectively (column 4, lines 5-8). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the first and second sensors taught by Murphy with the tension means of Kuhn et al. The motivation would have been to provide more responsive control of the feeding and tension of the tape web.

12. Examiner would like to note that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997); “[A]pparatus claims cover what a device is, not what a device does.” Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). See MPEP § 2114.

13. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent NO. 6,634,401 to Kuhn et al. as applied to claim 1 above, and further in view of U.S. Patent No. 3,860,473 to Wesen.

14. With respect to claim 5, Kuhn et al. does not specifically disclose said pre-cutting means includes a die receiving plate and a die roller having a cutter blade formed on a roller.

15. Wesen discloses an apparatus for making labels, including said pre-cutting means includes a die receiving plate (205) and a die roller (201) having a cutter blade (200) formed on a roller (see Figure 4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the cutting means taught by Wesen for the precutting means of Kuhn et al. Simple substitution of one known cutting device for another would produce the predictable result of effectively cutting labels from a web.

16. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent NO. 6,634,401 to Kuhn et al. as applied to claim 1 above, and further in view of U.S. Patent Application Publication No. 2003/0044481 to Beaudry.

17. With respect to claim 6, Kuhn et al. does not specifically disclose said pre-cutting means includes a movable roller and a die plate having a circular blade formed thereon.

18. Beaudry discloses a cutting device for use with labels (see paragraph 0002), including said pre-cutting means includes a movable roller (26) and a die plate (see

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paragraph 0063) having a circular blade formed thereon (32; see Figure 13). It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the cutting means taught by Beaudry for the precutting means of Kuhn et al. Simple substitution of one known cutting device for another would produce the predictable result of effectively cutting labels from a web.

19. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent NO. 6,634,401 to Kuhn et al. as applied to claim 1 above, and further in view of U.S. Patent No. 6,767,426 to Yamamoto.

20. With respect to claim 7, Kuhn et al. does not specifically disclose a die receiving plate and a blade disposed on a rotation member which is rotatable by a motor.

21. Yamamoto discloses a tape cutting apparatus, including a die receiving plate (7) and a blade (25) disposed on a rotation member (24) which is rotatable by a motor (23; See Figure 3). It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the cutting means taught by Yamamoto for the precutting means of Kuhn et al. Simple substitution of one known cutting device for another would produce the predictable result of effectively cutting tape from a web.

Response to Arguments

22. Applicant's arguments with respect to claims 1-2 and 5-7 have been considered but are moot in view of the new ground(s) of rejection. Applicant's amendment necessitated the new grounds of rejection.

Conclusion

23. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KIMBERLY K. MCCLELLAND whose telephone number is (571)272-2372. The examiner can normally be reached on 8:00 a.m.-5 p.m. Mon-Thr.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip C. Tucker can be reached on (571)272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kimberly K McClelland/
Examiner, Art Unit 1791

KKM

/Philip C Tucker/
Supervisory Patent Examiner, Art Unit 1791